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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,844	07/11/2003	Fred F. Schleifer	ELSE-0819	7986
23377	7590	03/30/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR 1650 MARKET STREET PHILADELPHIA, PA 19103			KOBERT, RUSSELL MARC	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,844	SCHLEIFER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Russell M. Kobert	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 January 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 7-33 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-9 is/are rejected.
- 7) Claim(s) 10-20 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1003 & 0105.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

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1. Applicant's arguments filed January 20, 2005 have been fully considered but they are not persuasive:

***Response to Restriction Argument***

The Examiner does not disagree with Applicants argument that there is no requirement under law to require admission by Applicants that the groups are not patentably distinct. However, Applicants have not shown why the inventions are not patentably distinct in response to the Examiner's reasons provided in the Restriction. The rules do allow for patentably distinct inventions. Applicants' argue that the search for two separate inventions within the same class and subclass presents no added burden. The Examiner has shown in the Restriction why the inventions are patentably distinct. The search for both patentably distinct inventions would present additional burden to the Examiner because each invention is unique by itself and each invention presents independent and distinct subject matter from each other that requires its own focus and separate search strategies thus placing additional time and effort by the Examiner to locate each of the independent and distinct inventions.

***Response to Intended Use Argument***

In response to applicant's argument that claim 7 recites additional structure in the terms used such as "for measuring electrical energy usage over a wide dynamic range

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of service voltages, wherein the electrical energy meter is used by an electric utility for customer billing purposes," "can be connected to a polyphase ..." and "capable of receiving any input voltage within the wide dynamic range of standard service voltages," and that such items are not merely statements of intended use but provide additional structure for the power supply element of the electrical energy meter because the language results in a structural difference between the claimed invention and the prior art, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). With respect to the instant application, it is noted that Kraley et al (4055803) is structured to be capable of measuring electrical energy usage over a wide dynamic range of service voltages, wherein the electrical energy meter is used by an electric utility for customer billing purposes, can be connected to a polyphase electrical service to measure electrical energy on more than one phase at a time (col 2, ln 43-45). Moreover, because Kraley et al indicates the use of a voltage regulator (described at column 6, lines 16-28; specifically noting the "voltage regulating Zener diodes 63 and 64") indicates that a variance in the voltage applied to the first winding is anticipated. Additionally, the Examiner has given full consideration to each recitation of the claims.

***Response to Applicants' Traversal to the Rejection Under 35 U.S.C. 102(b)***

For the reasons noted *supra*, each argument, that Kraley et al fails to show that it can be connected to a wide range of service voltages, is hereby deemed moot. Moreover, the Examiner disagrees with Applicants' interpretation that Kraley et al fails to support the notion that the output voltage is predetermined independent of the input voltage and fails to teach a predetermined voltage (in retrospect to the teaching of Kraley et al having multiple voltages; +13 Volts, +6.2 Volts, -6.2 Volts or -13 Volts). On the contrary, each voltage produced by the power supply of Kraley et al is a predetermined voltage because that is the desired output that results from Kraley et al teaching of a regulated power supply thereby independent of the input voltage.

***Response to Applicants' Comments on the Information Disclosure Statement***

The information disclosure statement filed October 14, 2003 fails in-part to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file however each cited reference referred to therein that is not available to the Examiner has not been considered. The Examiner has considered each cited reference currently available from Applicants' parent applications

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in addition to that which is available from other electronic resources. Those references not available to the Examiner have been crossed through. In the IDS filed October, 14, 2003 and attached hereto, each U.S. Patent cited has been crossed through as these were previously considered in the Office Action mailed on October 20, 2004. Additionally, all references to Court Proceedings will not be published and as such those references have been crossed out however any reference to Court Proceedings, that has been considered, has been initialed.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,621,629. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to have used the electric energy meter used in the instant application within the teaching of the 5,621,629 patent because claim 1 of the 5,621,629 patent refers to a power

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supply for use in *an apparatus for electrically measuring electrical energy supplied by an electrical service provider* (service utility). Moreover the 5,621,629 patent, read in light of the specification, refers to such an apparatus as a meter 10 (col 4, ln 23-44) shown in Figure 1.

4. Claim 7 contains limitations directed to intended use such as "for measuring," and "capable of." In consideration of the limitations as claimed, no patentable weight has been given to the functional language "for measuring electrical energy usage over a wide dynamic range of standard service voltages, wherein the electrical energy meter is used by an electric utility for customer billing purposes," "can be connected to a polyphase ..." and "capable of receiving any input voltage within the wide dynamic range of standard service voltages."

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraley et al (4055803).

Kraley et al anticipates (Figure 2) an electric energy meter (col 1, ln 37-41) for measuring electrical energy usage over a wide dynamic range of standard service

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voltages, wherein the electrical energy meter is used by an electric utility for customer billing purposes, and wherein the electrical energy meter *can be* connected to a polyphase electrical service (col 10, ln 53-64) to measure electrical energy on more than one phase at a time, the meter having a power supply comprising: a transformer (7') having first (left side) and second (52) windings, the power supply being *capable of* receiving any input voltage within the wide dynamic range of standard service voltages, which input voltage is provided to the first winding so that current flows through the first winding, wherein the second winding defines an output of the power supply, wherein the output is regulated (circuit electrically connected to 52; col 6, ln 16-28) to provide a predetermined output voltage (any one of +13 Volts, +6.2 Volts, -6.2 Volts or -13 Volts) independent of the input voltage, and wherein the wide range of service voltages include RMS voltages *between about* 96 Vrms and about 528 Vrms; as recited in claim 7.

As to claim 9, having a charge means (58 or 59) connected to the second winding for storing an electrical charge when current is flowing through the first winding and for discharging stored electrical charge when current flowing through the first winding is interrupted is anticipated by Kraley et al.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claims 10-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The added limitation wherein a switching member is connected to the first winding, a controller is connected to the switching member and to the third winding as further detailed in claim 10 has not been found. It is further noted that the examiner's reasons are understood to be predicated upon consideration of each of the claims as a whole, and not upon any specific elements of the claims.

8. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963. The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034. For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert  
Patent Examiner  
Group Art Unit 2829  
March 22, 2005

  
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PRIMARY EXAMINER  
A.U. 2829  
03/24/05